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IN THE

Supreme Court of the United States

OCTOBER TERM, 1954

No. .....

BAUSCH & LOMB OPTICAL CO.,

Petitioner,

v.

DEAN A. LYON,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

TO THE HONORABLE THE CHIEF JUSTICE OF THE UNITED STATES AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

The petitioner above named prays that a writ of certiorari issue to the United States Court of Appeals for the Second Circuit to review the decision and judgment of that Court in this action.

In accordance with Rule 21 (3) (4) of this Court petitioner files herewith a certified copy of defendant-appellant's Appendix filed in the Court below (Vols. I and II) and plaintiff-appellee's Appendix filed in the Court below together with the proceedings in the Court below (Vol. III) and nine copies of each of said appendices.

Opinions of the Courts Below

The opinion of the Court of Appeals for the Second Circuit, dated June 20, 1955, affirmed a judgment holding valid and infringed all claims in suit (*i. e.*, 1, 2, 4, 5, 8 and 9) of plaintiff's patent for a Method For Coating Optical Elements. The opinion of the Court of Appeals appears in the Appendix to this petition at page 1a and is reported in 106 USPQ 1.

That Court's opinion, dated July 29, 1955, on the petition for rehearing filed by petitioner here (defendant-appellant below) denied the same except it held claims 1, 2, 4 and 5 invalid but otherwise affirmed the judgment as to claims 3, 8 and 9. The opinion on rehearing appears at page 20a of the Appendix to this petition and is reported in 106 USPQ 240.

The opinion of the District Court dated December 31, 1953 appears in Volume II D.A., at page 910a and is reported in 119 F. Supp. 42 and, together with the findings of fact, is also reported in 100 USPQ 100.

Statement of Grounds on Which Jurisdiction is Invoked

The grounds on which jurisdiction of this Court is invoked are that the United States Court of Appeals for the Second Circuit by its decision herein has decided important questions of federal law in a way in conflict with applicable decisions of this Court and in conflict with applicable decisions of other United States Courts of Appeals for other Circuits and with earlier decisions of its own involving the same basic principles of law.

The judgment of the Court of Appeals sought to be reviewed was dated and entered on June 20, 1955 and appears at page 18a in the Appendix to this petition.

The order on the petition for rehearing by the defendant-appellant was dated and entered July 29, 1955 and appears in the Appendix to this petition at page 21a. Plaintiff-appellee did not file a petition for rehearing under the leave granted to him by said order.

The jurisdiction of this Court is invoked under the provisions of 28 U. S. C., Section 1254 (1) and Section 2101 (c), and Section 1 (b) of Rule 19 of this Court.

Questions Presented for Review

1. Did the decisions of this Court and the conforming decisions of the lower courts, on the test of patentable invention, during the period of twenty-five years preceding the Patent Act of July 19, 1952, change "the classical test of invention" applied by the courts since *Hotchkiss* v. *Greenwood* (1850), 11 How. 248, and, if so, has the 1952 Act, Sec. 103, overruled and nullified such decisions by "restoring the law to what it was" before such decisions were rendered, so that plaintiff's patent, which the Court below found was "almost certain" to "have been held invalid" before the Act, has now been validated by the Act?

2. Can a patent as to which the Court of Appeals found "it is almost certain that the claims would have been held invalid" prior to the 1952 Act and which the Court held to be validated by the Act, *ex post facto* support an award of damages for infringement which occurred during such period of invalidity prior to the Act, in view of Sec. 5 of the Act which, in repealing the applicable sections of prior patent acts, provided that "Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal"?

3. Where the prior art taught, disclosed and used the process of heating the glass while depositing a vaporized metal in a vacuum (as found by the District Court and by the Court of Appeals) for the same purpose of cleaning the glass for intimate contact with coatings of metals, was it a new use and invention under Sec. 100 (b) and under Sec. 103 of the 1952 Act, to employ the same process with known and analogous materials (metal fluorides) to accomplish the same cleaning function and produce a known coated product, under the decisions of this Court, such as *Brown* v. *Piper et al.* (1875), 91 U. S. 37; *Paramount Publix Corp.* v. *American Tri-Ergon Corp.* (1935), 294 U. S. 464?

4. Can a successful and commercial practice of a process be later discarded and disregarded as an abandoned experiment because not brought "to light in the art" nor "urged for adoption" by widespread publication, or because that commercial use was of only limited or "small scale" volume, contrary to the uniform decisions of this Court, such as *Egbert* v. *Lippmann* (1881), 104 U. S. 333; *Corona Co.* v. *Dovan Corp.* (1928), 276 U. S. 358 and *Electric Storage Battery Co.* v. *Shimadzu* (1939), 307 U. S. 5?

Statutes Involved

Prior Statute, R. S. 4886, 35 U. S. C. 31, 1946 ed. Inventions Patentable:

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country,

before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor." (R. S. sec. 4886; Mar. 3, 1897, ch. 391, sec. 1, 29 Stat. 692; May 23, 1930, ch. 312, sec. 1, 46 Stat. 376; Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212.)

1952 Patent Codification Act, 35 U. S. C. Sec. 100(b). Definitions—

"The term 'process' means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material."

Sec. 101. Inventions Patentable—

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

Sec. 102. Conditions for Patentability; Novelty and Loss of Right to Patent—

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) the invention was patented or described in a printed publication in this or a foreign country or in

public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

• • • •

"(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

Sec. 103. Conditions for Patentability; Non-obvious Subject Matter—

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Sec. 252. Effect of Reissue—

"No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original

patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue."

The foregoing Code Sections are parts of Section 1 of the Patent Act of July 19, 1952, Public Law 593, Chapter 950, 82 Congress, 2d Session. Sections 4(a), (e) and 5 of the Act are as follows:

Sec. 4. (a) "This Act shall take effect on January 1, 1953 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided."

Sec. 4. (e) "Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction."

Sec. 5. "The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal." (Schedule including R. S. Sec. 4886)

Statement of the Case

The Petitioner and other manufacturers were engaged before the late war in the commercial production of lenses coated with light-transmitting films of molecular thickness, for reducing the reflection and wastage of light at the surface of incidence on the lens (Finding 5). Such films were applied in an evacuated container by heating and vaporizing the coating material so that it was condensed and deposited as a thin film on the lens surface (Vols. I and II, D. A. 270a, 845a, Deft's. Exh. D-52). It was known that a more tenacious and hard film was produced by heating the lens, before being coated in the vacuum (preheating) to vaporize and drive off surface impurities and thus clean it for intimate contact with the coating, and it was known that heating the coated lens (post-baking) improved the tenacity and ruggedness of the coating, substantially as recognized in plaintiff's patent specification, particularly as originally filed at the Patent Office (Vol. II, D. A. 552a, 559a).

It was known practice also in coating with such light-transmitting (reflection-reducing) films, as well as with opaque (light-reflecting) films, to heat the lens while being coated in the vacuum, for the same purpose of cleaning it, and this step had been described in printed publications and used openly in commercial production prior to plaintiff's alleged invention, as hereafter pointed out. This known step, however, is designated by plaintiff's specification as the invention of his patent, as hereafter referred to.

Plaintiff was employed as a technician by the Navy Department in January, 1941, to learn such coating technique and install it among the suppliers of optical elements for the armed services. He read the literature of the art, visited the plants of defendant and other manufacturers of coated optical elements (Vol. III, P. A. 2a; Vol. I, D. A. 528a-529a) and, as he stated in a published address at the

time (Vol. I, D. A. 531a) he "stumbled upon that *old idea* of heating the elements in a vacuum," as the slow but most intensive method of cleaning the lens glass to obtain an intimately contacting and tenacious film, to suit the severe usage of military field service. The Navy Department then required use of this technique by defendant and all suppliers of Government optics.

Plaintiff's application (Vol. II, D. A. 549a, 554a) filed by the Navy Department Nov. 17, 1942, disclosed the process as applicable to any "*suitable coating material*", for coating mirrors, lenses and the like, specifically disclosing both the metal fluorides which form light-transmitting coatings as well as the metal sulfides which form light-reflecting or opaque coatings. The patent application was repeatedly rejected by the Examiner on reference to several prior patents disclosing the identical process in use for applying light-reflecting, metallic films, to "silver" mirrors, and on reference to several other patents disclosing the application of light-transmitting films (metal fluorides) by evaporation in vacuum and heating the glass before the vacuum for the same cleaning purpose and heating the coated lens to improve the tenacity and hardness of the coating. The Examiner held that no invention was required to use the known "silvering" method of coating on hot glass and substitute a known light-transmitting material (metal fluoride) as the coating material. He held, in the alternative, that no invention was required to use the known process for depositing light-transmitting materials and to heat the glass in the vacuum, instead of heating it before and after the vacuum (Vol. II, D. A. 569a, 578a).

The claims were then restricted by amendment (Vol. II, D. A. 560a, 576a, 582a) to the known process of coating on hot glass, but in use with "inorganic salts" (claims 1, 2, 4 and 5) and more specifically with light-transmitting inorganic salts which include the metal fluorides (claims 3, 8 and 9). The claims were thus distinguished from the

prior patents; i.e., instead of claiming the use of metal in the old and known process, the claims claim the known and analogous coating materials (inorganic salts and metal fluorides) in that same process to make a known coated lens product (Cartwright patent 2,207,656, Vol. II, D. A. 781a). After persistent argument by the Government solicitors, and an "interview" with the Examiner, he withdrew the rejection of the claims but without any relevant or adequate explanation (Vol. II, D. A. 600a, 602a).

After the war, defendant continued the use of the accused process, both as required to supply the Government and its commercial production, without knowledge of any claim to patent rights. Plaintiff's patent was issued April 16, 1946, and this suit was begun May 6, 1949. It was tried without a jury in the District Court for the Western District of New York on July 8, 1952, at which time plaintiff was allowed to amend to include a claim for breach of confidential disclosure. Defendant denied any such breach and denied the validity of the patent on several grounds, but admitted infringement if the patent should be held valid.

Defendant relied in part on the prior patents cited by the examiner, supplemented by others of cumulative effect. In addition, defendant produced a patent to Cartwright et al., No. 2,207,656 (not before the Examiner), disclosing the coating of lenses with light-transmitting, reflection-reducing films of metal fluorides and teaching the application of such coatings "in the manner now generally well known in the silvering of mirrors and the like," (Vol. II, D. A. 782a, col. 1, line 21) thus suggesting the method of the Examiner's patent citations in which the glass is heated during coating with silver in the vacuum. It was proven that this silvering process had been in use for years by Sylvania Electric Products, Inc. in the quantity manufacture of mirror surfaces on lamp bulbs (Vol. I, D. A. 475a-523a).

The District Court distinguished such patents on the ground that while some of them disclosed the deposit of metal films on hot glass, other patents disclosed the deposit of metal salts on unheated glass and that it required invention to see that the glass could be heated and cleaned in the same way and for the same purpose when depositing metal salts (Vol. II, D. A. 914a). The Court of Appeals adopted the same view, but mistakenly held that the invention disclosed by plaintiff's specification is limited to coating with light-transmitting materials and thus "widely diverged" from the prior patents.

In addition, defendant produced an article (not before the Examiner) published in a scientific magazine in 1931 by Cartwright, the patentee, in which (Vol. II, D. A. 743a) he described the identical process of coating on hot glass, for applying a class of materials including not only metals but also the light-transmitting, reflection-reducing metal salts of plaintiff's patent ("the alkali halides" including "fluorite" or calcium fluoride). Plaintiff so testified (Vol. I, D. A. 68a-70a) and that he had previously read this article (Vol. I, D. A. 67a) which described the use of the process with such materials, in the usual exemplary way, by describing the deposit of one of them (silver) on glass heated in the vacuum to clean it during coating (Vol. II, D. A. 746a). The District Court found that this publication described the identical process (Vol. II, D. A. 915a) but rejected it because describing its application to only one of the disclosed materials and reached the conclusion that it was not obvious to one skilled in the art, that the process could be employed to deposit any of the other materials (including metal fluorides), which the article expressly designated for use in the same process. The Court of Appeals avoided any reference to this publication, although it was briefed and argued as a complete anticipation, both on the appeal and in the Petition for Rehearing.

Both Courts found that Dr. Cartwright while an instructor in the physics department at M. I. T. in 1939-1940, had

followed up his previous work and publications on coatings, by carrying on a limited commercial business of coating lenses (Vol. II, D. A. 916a-917a; Appendix 8a-9a) in the course of which he employed the identical process claimed in plaintiff's patent, as a side line "in a small scale commercial business of coating optical elements for persons and corporations who had become familiar with his work" (Vol. II, D. A. 939a-940a) with unrestricted disclosures to others (Vol. II, D. A. 916a, 920a-921a) including Dr. Hewlett* of the General Electric Company (Vol. II, 942a) and that as a result of the notoriety of his work in demonstrating the practical utility of such films, Cartwright was so besieged with orders for coatings as to necessitate the hiring of an assistant to fill them (Vol. II, D. A. 916a, 917a, 939a-940a).

But the Court of Appeals, notwithstanding such findings, adopted the conclusions of the District Court that Cartwright's use of the process, "in his commercial work, had convinced him that it was inferior in results" to other methods of coatings; that he failed to "properly evaluate" the patented method or to conclude that it was "the best method for obtaining hard and rugged coatings"; that Cartwright's commercial user was only on a "small scale" and "sporadic" and that he "did not bring it to light in the art, nor urge its adoption" (Vol. II, D. A. 919a, 916a, 939a-942a). The Court of Appeals, adopting such reasoning, concluded that Cartwright's work was not a completed discovery and reduction to practice, nor prior knowledge

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* Both Courts found that Dr. Hewlett of the research staff of the General Electric Company, corresponded with Dr. Cartwright and carried on a parallel practice of the claimed invention (Vol. II, D. A. 920a-921a, 942a). Hewlett, having reduced the method to practice and evaluated it, concluded that it was an unnecessary refinement and expense for cover glasses of electrical meters and decided for that reason not to put it in production (Vol. I, D. A. 357a, 367a-368a, 374a-375a).

and use, nor public use, but only a discovery which was abandoned "as soon as it emerged from the stage of experiment" (App. 9a-10a).

The judgment of District Court was entered January 25, 1954, holding the claims in suit, Nos. 1 to 5, inclusive, and 8 and 9, valid and infringed and ordering an injunction and an accounting, but dismissing the claim of breach of confidential disclosure. The question of the effect of the 1952 Patent Act was not raised nor decided in the District Court. Only the defendant appealed.

In the Court of Appeals, it was not contended that the 1952 Act, Sec. 103, had changed the decisional law as to the test of invention. In fact, plaintiff's brief cited and relied on the prior decision of this same Court of Appeals in *Channel Master Corp.* v. *Video Television Inc.* (E. D. N. Y., 1953), 117 F. Supp. 812, 815, aff'd 209 F. 2d 511 (C. A. 2, 1953), to the effect that the Act, Sec. 103, did not change the law. That question was first injected into the case at bar by that Court at the hearing on appeal and in its opinion that the decisions of this Court in the twenty-five years before the Act, changed the decisional law and that the Act, by "restoring the law to what it was," now again authorizes some vaguely greater liberality for the test of invention than was applied in such decisions (Appendix, p. 12a). In pursuit of that view, the Court of Appeals brushed aside or ignored the proofs of lack of novelty and invention (Sec. 103) and failed to apply the statutory defenses (Secs. 101, 102).

The opinion of the Court of Appeals, filed June 20, 1955, thus affirmed the judgment of the District Court, holding all of the claims in suit valid and infringed. The defendant filed a Petition for Rehearing on July 11, 1955, within the time therefor as extended by the Court. In its decision on the rehearing, the Court modified its opinion, holding claims 1, 2, 4 and 5 invalid for lack of disclosure. This petition for a writ of certiorari is timely filed.

Federal Jurisdiction of the District Court

This is a civil action under the Acts of Congress relating to patents and the jurisdiction of the Court of first instance is based upon 28 U. S. C. 1338 (a) and 1400 (b).

Reasons and Argument

Question 1. The decision below has decided an important federal question with respect to whether or not the Patent Act of 1952, which took effect on January 1, 1953, effected a change in the application of the standard of invention enunciated and applied by this Court and by the lower Courts in conformity therewith. The opinion below has decided this question in a way that is in conflict with the provisions of the Act and the intent of Congress, and is in direct conflict with the applicable decisions of Courts of Appeals in other Circuits involving the same question.

The Court of Appeals recognized that the Act, Sec. 103, by prescribing the test of obviousness to a person having ordinary skill in the art, merely enacted the classical test of the decisional law since *Hotchkiss* v. *Greenwood*. Thus the Court below said:

> "* * * § 103 only restores the original gloss, substantially in ipsissimis verbis; which has never been overruled; but on the contrary for seventy or eighty years had continued to be regarded as authoritative."

Such was the law as interpreted and applied in the decisions of this Court, during the twenty-five years before the Act, which the Court of Appeals has criticized as changing the law. But the Courts of Appeals of the other Circuits have held, on the contrary, that such decisions of this Court did not change the test or standard of invention but only required a more strict determination of what would have been obvious to one of ordinary skill in the

art; that such decisions of this Court have merely reaffirmed what this Court said long ago in *Atlantic Works* v. *Brady* (1882), 107 U. S. 192, 200. Even in *Cuno Engineering Corp.* v. *Automatic Devices Corporation,* 314 U. S. 84, sometimes construed as requiring the most strict application of the standard, this Court stated its adherence to the principle of *Hotchkiss* v. *Greenwood* and any extreme interpretation of the expression "flash of creative genius" in the *Cuno* decision is unwarranted and has been guarded against in the second sentence of Section 103.*

> *Pacific Contact Laboratories* v. *Solex Laboratories,* 209 F. 2d 529, 533 (C. A. 9, 1953), cert. den. 348 U. S. 816.

This Court has said that the standard of patentability is a Constitutional standard. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.* (1950), 340 U. S. 147, 154. In requiring a strict application, this Court was not deviating from, but reaffirming the Constitutional intent which is binding upon Congress.

> *Avery* v. *Ever Ready Label Corp.,* 104 F. Supp. 913 (D. C. N. J., 1952).

The 1952 Act, Sec. 103, so far as here pertinent (first sentence) contains no provision in reference to the standard of invention beyond the bare enactment of the classical test of obviousness. It is bare of any support for any inference that Congress disapproved the criticized decisions of this Court and such fact supports the conclusion that if Congress meant so much, it would not have said so little.

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* Similar expressions, *i. e.,* "inventive genius", "intuitive genius", and the like, had long been used by the Supreme Court. *Reckendorfer* v. *Faber* (1875), 92 U. S. 347, 357; *Smith* v. *Whitman Saddle Co.* (1893), 148 U. S. 674, 681; *Potts* v. *Creager* (1895), 155 U. S. 597, 607; *Concrete Appliances Co.* v. *Gomery* (1925), 269 U. S. 177, 185; *Mantle Lamp Co.* v. *Aluminum Products Co.* (1937), 301 U. S. 544, 546.

The legislative history of the Act, furthermore, plainly establishes that it was not the intent of Congress to overrule the decisions of this Court. The Reports of the Senate and House Committees in reporting the Bill have been quoted and considered at length in many decisions uniformly holding the above conclusion, such as the following:

Stanley Works v. *Rockwell Mfg. Co.*, 203 F. 2d 846 (C. A. 3, 1953), cert. den. 346 U. S. 818;
General Motors Corp. v. *Estate Stove Co.*, 203 F. 2d 912 (C. A. 6, 1953), cert. den. 346 U. S. 822;
Joseph Bancroft & Sons Co. v. *Brewster Finishing Co.*, 113 F. Supp. 714, 721 (D. C. N. J., 1953), aff'd. 210 F. 2d 677;
New Wrinkle, Inc. v. *Watson*, 204 F. 2d 35, 37 (C. A. D. C., 1953) cert. den. 346 U. S. 820;
In re O'Keefe, 202 F. 2d 767, 771 (C. C. P. A., 1953).

The Court of Appeals said in reference to decisions that have passed upon the question whether the Act changed the standard of invention as previously defined by this Court, "so far as we have found none of them has held that § 103 did not change the standard of invention." The fact is, on the contrary, that this same Court had previously affirmed, *per curiam*, a decision by Judge Inch of the Eastern District of New York, specifically holding that the Act did not change the standard of invention.

Channel Master Corp. v. *Video Television, Inc.*, 117 F. Supp. 812, 815 (D. C. E. D. N. Y., 1953), aff'd. 209 F. 2d 511 (C. A. 2, 1953).

It has been uniformly so held in the other Circuits and no decision has been found to the contrary except the decision below in this case:

Wasserman v. *Burgess & Blacher Co.*, 217 F. 2d 402 (C. A. 1, 1954);

Stanley Works v. *Rockwell Mfg. Co.*, 203 F. 2d 846 (C. A. 3, 1953), cert. den. 346 U. S. 818;
Joseph Bancroft & Sons Co. v. *Brewster Finishing Co.*, 113 F. Supp. 714, 721 (D. C. N. J., 1953), aff'd. 210 F. 2d 677;
Interstate Rubber Products Corp., et al. v. *Radiator Co. et al.*, 214 F. 2d 546 (C. A. 4, 1954);
Fritz W. Glitsch & Sons v. *Wyatt Metal & Boiler Works*, 106 USPQ 162, 164-165 (C. A. 5, 1955);
General Motors Corp. v. *Estate Stove Co.*, 203 F. 2d 912 (C. A. 6, 1953), cert. den. 346 U. S. 822;
Pacific Contact Laboratories v. *Solex Laboratories*, 209 F. 2d 529 (C. A. 9, 1953), cert. den. 348 U. S. 816;
New Wrinkle, Inc. v. *Watson*, 204 F. 2d 35, 37 (C. A. D. C., 1953), cert. den. 346 U. S. 820;
In re O'Keefe, 202 F. 2d 767, 771 (C. C. P. A., 1953);
Thys Co. v. *Oeste*, 111 F. Supp. 665, 673 (D. C. N. D. Cal. N. D., 1953, aff'd. 219 F. 2d 131);
Modern Art Printing Co. v. *Skeels*, 123 F. Supp. 426, 432 (D. C. D. N. J., 1954);
DeBurgh v. *Kindel Furniture Co.*, 125 F. Supp. 468, 474 (D. C. W. D. Mich. S. D., 1954).

In enacting the test of invention as it had been defined by the decisions of this Court, and without more, it is plain that Congress did not intend to overrule the decisions of this Court, but, on the contrary, to confirm them.

In the pursuit of its contrary version and in view of the lack of novelty or invention, the Court of Appeals was led inescapably to the conclusion that the patent would have been held invalid by this Court, stating: "it must be owned that, had the case come up for decision within twenty, or perhaps, twenty-five, years before the Act of 1952 went into effect on January 1, 1953, it is almost certain that the

claims would have been held invalid" (Appendix 11a). *It was thus the opinion of the Court below that, but for the Act and its version thereof as overruling the decisions of this Court during those twenty to twenty-five years, the patent would be invalid under those decisions of this Court.*

The decision sought to be reviewed was turned on the subject of the proper standard of invention, the most important question of patent law. The decisions cited above show that the Courts of and in other Circuits are uniformly applying the standard of invention of the Act as defined and applied by the decisions of this Court in the previous twenty-five years. The decision below, after stating that the "authoritative" and "original gloss" of *Hotchkiss* v. *Greenwood* is embodied in Section 103 of the Act, implicitly holds that the later applications of this gloss by this and other Courts have been "indefinite" "but indubitably stricter" than the test of invention defined in Section 103; have "obscured [that gloss] by a series of later comments whose upshot is at best hazy"; and have been "too amorphous" to provide any assurance the public might have drawn from earlier decisions—i. e., before the effective date of the 1952 Act (Appendix 11a, 15a).

This creates confusion of the first order for there is nothing in the Act itself nor in the legislative history that explicitly or implicitly overrules the decisional law with respect to the standard of invention or its application from the time of *Hotchkiss* v. *Greenwood* to the effective date of the Act.

In any event the opinion below is in direct conflict with another decision of the same Court and is in direct conflict with other Circuits as to whether the 1952 Act is to be applied in accordance with the decisions of this Court of the last twenty-five years or in accordance with some undefined but less strict application of the standard of invention applied twenty-five years or more before the 1952

Act by some of the Courts but repeatedly condemned by this Court as early as 1882 in *Atlantic Works* v. *Brady, supra,* and as recently as 1950 in the *A. & P.* case, *supra.*

Question 2. The decision sought to be reviewed is in further confusion and conflict in its award of damages for infringement during the period before the 1952 Act when the Court concluded the patent would have been held invalid. Defendant relies on the self-evident proposition that there can be no infringement of an invalid patent and that it was necessary for the Court below to either find that the patent was valid before the Act, or else deny such damages, to avoid *ex post facto* enforcement of the patent, for such is not favored in the eyes of the law.

Defendant contends that such *ex post facto* enforcement is expressly prohibited by Sec. 5 of the Act which, in repealing sections of the prior Statutes, provided:

> "Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal."

Defendant contends also that any such *ex post facto* enforcement is inconsistent with the principle of intervening rights under reissued patents as now enacted in Sec. 252 of the Act.

The Court below raised this issue for the first time in its opinion and resolved it without having the benefit of a full briefing and argument.

Question 3. Question numbered 3 is directly related to the first question and necessarily should be considered along with question numbered 1 because the proper application of the standard of patentability and invention under the 1952 Act is the underlying basis for a proper decision of Question 3.

The identical steps of the patented process of heating glass while depositing a vaporized material in a vacuum for the same purpose of cleaning the glass for intimate contact with coatings of metals were known and used. Both Courts below found that several prior patents, publications and uses disclosed the same process of coating on hot glass with light-reflecting metals and also that several other patents disclosed the same process of coating with plaintiff's light-transmitting metal salts except for deposit on cold glass.

It was the Patent Office Examiner's considered and repeated judgments, in view of such patents, that it was obvious to one skilled in the art to coat hot glass with metal salts, notwithstanding his unexplained allowance of the claims at the insistence of the plaintiff's Navy Department solicitors. The Examiner rejected claims to the same process in the application of the Eastman Company employee, Beggs, until the issue of plaintiff's patent necessitated an interference (Vol. II, D. A. 644a, 648a, 651a, 655a). He rejected claims to the same process in the application of Osterberg *et al.* and the rejection was affirmed by the Board of Appeals (Vol. II, D. A. 872a, 890a). Of these several applicants, only the plaintiff succeeded in overcoming the Patent Office resistance.

The Court of Appeals misconstrued plaintiff's specification as "only for a 'light-transmitting optical' element" (Appendix 4a). At the rehearing, it was pointed out, on the contrary, that the plaintiff's specifications disclosed the use of the process with any "suitable coating material" including opaque, light-reflecting materials (the metal sulfides). As a result, the Court invalidated the claims not limited to light-transmitting coatings (claims 1, 2, 4 and 5) for lack of adequate disclosure. But the more compelling reasons for invalidating the claims were the disclosure by the prior patents and publications of coating on hot glass, and the indefiniteness and over-claiming of plaintiff's claims at the point of novelty, rather than the lack of disclosure relied on by the Court.

"• • • Cowles has no right to claim the feature of incombustibility as his invention, since nothing is better settled in this court than that the application of an old process to a new and analogous purpose does not involve invention, even if the new result had not before been contemplated." *Ansonia Brass & Copper Co.* v. *Electrical Supply Co.*, 144 U. S. 11 (1892), citing to the same effect *Pennsylvania R. Co.* v. *Locomotive Engine & S. T. Co.* (1884), 110 U. S. 490, 494 and many other decisions.

The adaptation of an old process to a new use does not, under the decisions of this Court, amount to invention. *Brown* v. *Piper, et al.* (1875), 91 U. S. 37; *Paramount Publix Corp.* v. *American Tri-Ergon Corp.* (1935), 294 U. S. 464; *General Electric Co.* v. *Jewel Co.*, 326 U. S. 242, 247 (1945). The net result of the opinion and the invalidating of the broad claims on rehearing clearly exposes the conflict of the decision by the Court of Appeals with the foregoing decisions of this Court with respect to invention in the remaining claims.

The District Court conceded that the 1931 publication of Cartwright disclosed the same process, including heating of the glass while being coated in the vacuum, as in plaintiff's patent. The only attempted distinction was that, in describing the use of the process, reference was made in an exemplary way to the metal, silver, as one of the class of coating materials disclosed by the publication for use in the process. The disclosed materials included those of plaintiff's patent and the Court held that it was not obvious to one skilled in the art that the glass could be cleaned in the same way when applying any of the other materials disclosed for use in the process. *It is impossible to understand how a contention so trivial could be seriously advanced as supporting a patent monopoly,* in the face of the defense of prior publication, before the plaintiff's invention and more than a year before his patent application, as provided in Sec. 102 (a) and (b).

The Court of Appeals avoided any reference to this publication, although it was urged on appeal and in the petition for rehearing.

Question 4. The decisions of the courts below, in failing to apply the rules of law applicable to the findings of fact, are in confusing conflict with the statutory and decisional law.

Under Sec. 101 of the Act, the claimed subject matter must have been "new" at the time of plaintiff's alleged invention. Under Sec. 102 (a), it must not have been "known or used" by others, or "patented or described in a printed publication" before the alleged invention. It has sometimes been contended that "known" should be taken to mean publicly known, but that has not become the law. It has not been contended that "used" means publicly used, because that is the additional provision of Sec. 102 (b).

Under Sec. 102 (b), it must not have been "patented or described in a printed publication" or "in public use or on sale" more than one year prior to the date of application for the patent.

These provisions of Secs. 101 and 102 continue in the same terms and do not purport to change the prior Statute, R. S. 4886, as held by this same Court of Appeals in the *Channel Master* case, *supra*.

The courts below failed to apply these rules of law to their concurrent findings as to the prior use by Cartwright.

The District Court found (Vol. II, D. A. 939a, 940a, Findings 27-29, 31) and repeatedly stated in its opinion (Vol. II, D. A. 915a-917a) that Cartwright knew and used the claimed invention in 1939, reduced it to practice successfully, used and disclosed it to others without secrecy and used it in the commercial production of coated lenses for profit. And the District Court said, "These admissions pose important questions, i. e., whether Cartwright

properly estimated the value of heating in the vacuum * * * whether he brought it to light in the art and urged its adoption." But these were not the questions required by the statute and the Court completely ignored the above statutory requirements as defined by the decisions of this Court.

The Court of Appeals confirmed the findings of the District Court and stated even more specifically that the evidence proved "beyond cavil that Cartwright did conceive that to coat the glass in a vacuum, while heated, made the coating 'very much harder,' but it also shows not only that he had practiced it, but that he considered * * * having it patented." Furthermore, that he disclosed such practice to his sponsor, Research Corporation, and disclosed it unrestrictedly to Dr. Hewlett of the General Electric Co. and that he used it in the coating of many lenses in a commercial business yielding an income as high as $3,000 a year. The Court further concluded that this was a public use of the claimed invention from 1939 on. But the Court then agreed with the conclusion of the District Court, that since Cartwright did not eventually prefer such method to that of heating the glass before or after coating, nor take steps to bring "it to light in the art" he "abandoned his discovery as soon as it emerged from the stage of experiment" (Vol. II, D. A. 923a, 942a; Appendix 9a).

Such a conclusion by the Court of Appeals is not only in flat contradiction of its own findings of fact; it is in direct contravention of the above statutory defenses, of the decisions of this Court, and of its own prior decisions and those of the other Courts of Appeal.

One defect is the failure to observe the distinction between an abandoned experiment and a completed discovery which was elaborated by this Court in Corona Co. v. *Dovan Corp.* (1928), 276 U. S. 358. In that case the Weiss patent was held invalid because the invention had been known to and used by Kratz in the company laboratory, although it was not published nor brought "to light in the art" until

after the invention by the patentee Weiss. This Court said of Kratz's laboratory work (pp. 382, 384):

> "• • • what he did at Norwalk, supported by • • • the indubitable records that are not challenged, leaves no doubt in our minds that he did discover in 1916 the strength of D.P.G. as an accelerator as compared with the then known accelerators, and that he then demonstrated it by a reduction of it to practice in production of cured or vulcanized rubber.
>
> "This constitutes priority in this case. It was not followed by commercial use thereafter, because of the then cost of D.P.G. But this patent is for the mere discovery and application in the making of rubber of a particular accelerator. It was the fact that it would work with great activity as an accelerator that was the discovery, and that was all, and the necessary reduction to use is shown by instances making clear that it did so work, and was a completed discovery. • • •
>
> "It is a mistake to assume that reduction to use must necessarily be a commercial use. If Kratz discovered and completed, as we are convinced that he did, the first use of D.P.G. as an accelerator • • • he does not lose his right to use this discovery • • • because he does not subsequently sell the rubber thus vulcanized, or use his discovery in trade, or does not apply for a patent for it. It is not an abandoned experiment because he confines his use of the rubber thus produced to his laboratory or to his lecture room."

The facts of the present case are stronger for the defendant than those of the *Corona* case for Kratz, because when Cartwright's discovery "emerged from the stage of experiment", as a completed discovery, it was immediately employed in several years of commercial production. The attempted distinction by the Court of Appeals that "the tests of Kratz" were not " 'abandoned laboratory experiments' ", is completely irrelevant to the present facts.

The well known text, Patentability and Validity by *Rivise & Caesar (The Michie Co., Charlottesville, Va., 1936)*, states at Sec. 58, page 90:

> "A careful distinction must be maintained between abandoned experiments and abandoned inventions. As has already been stated and illustrated, a successful invention cannot be defeated by prior experiments which were abandoned because unsuccessful. *Abandoned inventions, on the other hand, are just as effective as references against later developments as if they had never been abandoned.*" (Italics added)

In *Buser* v. *Novelty Tufting Machine Co.*, 151 Fed. 478, 493 (C. A. 6, 1907), cert. den. 210 U. S. 432, the Court said:

> "If, then, an alleged invention is in fact an invention, no subsequent abandonment of it can be said to be an abandoned experiment. At most, it is an abandoned invention. But an invention that has been abandoned is as much an anticipation, and to as great an extent negatives novelty, as an invention that has not been abandoned."

A further defect is that in discarding the prior user of Cartwright, the decisions of both Courts are in head-on conflict with the above statutory defenses of prior knowledge and use and public use and sale. Commercial use, or use on a continuous or large scale, or any use at all is immaterial.

> "If the invention is perfected, and put into actual use by the first and original inventor, it is of no consequence, whether the invention is extensively known or used, or whether the knowledge or use thereof is limited to a few persons, or even to the first inventor himself." *Reed* v. *Cutter, et al.*, 20 Fed. Cas. 435, 437 (C. C. D. Mass., 1841).

> "We do not understand the Circuit Court to have said that the omission of Conner to try the value of

his safe by proper tests would deprive it of its priority; nor his omission to bring it into public use. He might have omitted both, and also abandoned its use, and been ignorant of the extent of its value; yet, if it was the same with Fitzgerald's, the latter would not upon such grounds be entitled to a patent." *Gayler, et al.* v. *Wilder* (1850), 10 How. 477, 498.

"The rule undoubtedly is that a prior use, in order to negative novelty in a patent, must be something more than an accidental or casual one. It need not have been persisted in, and the thing produced need not have gone into commercial use; but at least the discovery must have gotten beyond the experimental stage and have become complete, and the inventor must have understood and appreciated that it was capable of producing the results sought to be accomplished." *American Stainless Steel Co.* v. *Rustless Iron Corp.*, 71 F. 2d 404, 407 (C. A. 4, 1934).

"Appellants rely on Corona Cord Tire Co. v. Dovan Corp. * * * that the reduction to practice of an invention can be completed by production of the article and the testing of it by an inexact practical test showing its operative character to a man skilled in the art, and of the further proposition that the invention need not be followed by commercialization to establish its completion, and that no abandonment can be presumed merely from the lack of commercialization. With those principles we are in complete accord." *Minnesota Mining & Mfg. Co.* v. *Van Cleef,* 139 F. 2d 550, 555-6 (C. A. 7, 1943).

To the same effect, see:

Standard Sanitary Mfg. Co. v. *Iron City S. Mfg. Co.*, 222 Fed. 671, 678 (C. A. 3, 1915);
St. John v. *Schulze,* 47 F. 2d 798, 802 (C. C. P. A., 1931).

A *single prior use,* not proven secret, is a bar to any later inventor:

> "The prior knowledge and use by a single person is sufficient. The number is immaterial." *Coffin* v. *Ogden,* 18 Wall. 120, 124.
>
> "The law is clearly established that a single prior public use for more than two years prior to the application for the patent makes the patent void." *Toch* v. *Zibell, etc.,* 231 Fed. 711, 716 (C. A. 2, 1916) (citing *Egbert* v. *Lippmann,* 104 U. S. 336 and *Hall* v. *Macneale,* 107 U. S. 90).

In *Grasselli Chemical Co.* v. *National Aniline & Chemical Co.,* 26 F. 2d 305, 309 (C. A. 2, 1928), the Court by Judge Hand said:

> "Once the invention has been embodied in goods which are put in public use it becomes impossible for a later inventor to secure a patent."

Publication of the discovery, or steps to bring "it to light in the art", or "urge its adoption" are not required by the statute. In *Gillman* v. *Stern,* 114 F. 2d 28, 31 (C. A. 2, 1940), cert. den. 311 U. S. 718, in distinguishing between "a public user which does not inform the public" and "a secret user", the court by Judge Hand said:

> "* * * it was irrelevant whether the use informed the public so that they could profit by it."

In *Rosaire* v. *Baroid Sales Division, National Lead Co.,* 218 F. 2d 72, 75 (C. A. 5, 1955), cert. den. 349 U. S. 916, the court said:

> "* * * no case we have found requires a holding that, under the circumstances that attended the work of Teplitz, the fact of public knowledge must be shown before it can be urged to invalidate a subsequent patent." (citing the *Corona* case)

After Cartwright's prior knowledge and use and public use before plaintiff's invention and more than a year before plaintiff's application, there was no authority in law for the issue of a patent to plaintiff.

Conclusion

The decision sought to be reviewed places on the act and its standard of invention an interpretation which challenges and is in expressed conflict with the decisions of this Court, with the interpretation of the act by the other Courts of Appeal and with the interpretation in its own earlier decision.

Such conflict is created by validating the patent on reasoning which flies in the face of the several statutory defenses and their settled application in the decisions of this Court and of the same and other Courts of Appeal.

Only an authoritative decision by this Court can clear up such conflict and confusion in the basic principles of the patent laws.

Respectfully submitted,

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September 9, 1955.

APPENDIX

[Volume III 304a]

United States Court of Appeals

FOR THE SECOND CIRCUIT.

No. 216 October Term, 1954.

Argued April 6, 1955. Decided June 20, 1955

Docket No. 23345

DEAN A. LYON,

Plaintiff-Appellee,

v.

BAUSCH & LOMB OPTICAL CO.,

Defendant-Appellant.

Before:

L. Hand, Swan and Hincks, Circuit Judges.

On appeal from a judgment for the plaintiff of the District Court for the Western District of New York (Burke, J., presiding), in an action for the infringement of patent No. 2,398,382, granted to the plaintiff on April 16, 1946.

Edward H. Cumpston (G. A. Ellestad on the brief) for the appellant.

John W. Malley (C. Willard Hayes and B. E. Shlesinger on the brief) for the appellee.

L. HAND, Circuit Judge:

This is an appeal from a judgment of the District Court for the Western District of New York (Burke, J., presiding), sustaining the validity of Patent No. 2,398,382, granted to the plaintiff, Lyon, on April 16, 1946, upon an application [Volume III 305a] filed November 17, 1942. Of the nine claims all but 6 and 7 are in suit; the judgment held all seven valid, and the defendant concedes infringement. Judge Burke, in a long and careful opinion (119 Fed. Sup. 42), has stated the evidence in such detail that we may, as we shall, assume familiarity with it in our discussion of the issues involved.

The defendant first challenges the sufficiency of the specifications to support the claims. Throughout the specifications the "coating" to be vaporized is described only as a "suitable coating * * * such as metallic fluoride, metallic sulphide, oxide or the like" (page 1, col. 2, lines 26-28), or "mixtures" of these (page 2, col. 1, lines 26-28). The first five claims speak of "a stable, water insoluble, evaporated inorganic salt," and of the last two claims in suit number eight is for a "metallic fluoride" and number nine for "magnesium fluoride." The defendant complains that "suitable coatings" is too vague a description, even when accompanied, as the phrase was, by the specific substances mentioned. Considering the kind of coatings that the art had been using, an acquaintance with which the applicant might impute to anyone practicing the process, this objection appears to us unduly captious and hostile to the underlying canons of patent interpretation. In any event, Finding 44 finds facts that dispose of the objection. Indeed, it cannot at any rate apply to claims 8 and 9 where the "inorganic salt" is described as "metallic fluoride," and "magnesium fluoride." As for the other claims in suit we can see no reason to suppose that when the "suitable coating" of the specifications is limited to a "stable, water insoluble, [Volume III 306a] evaporated inorganic salt," anyone

seeking to use the process would be left in doubt. The claims always measure and limit the scope of the monopoly; and the defendant does not, and could not properly, suggest that anything that Lyon actually invented he did not disclose when the limitations of the claims are imputed to the description in the specifications. Therefore we are not disposed to draw any distinction between claims 8 and 9 and the other five in suit, though, if we did, it would at most only result in a modification of the judgment not important in this action. As to the objection that the claims confuse or combine process and product, it is so patently untenable that we shall not discuss it.

The important questions are whether the invention had been disclosed in any earlier patent, or had been publicly used, before Lyon filed his application on November 17, 1942; and whether his contribution will support a patent. The process was in two steps: First, to heat the "optical surface" in a vacuum until "absorbed water and grease have been evaporated from the surface," (page two, col. 1, lines 47, 48); and second, to vaporize an "inorganic salt" within the vacuum, meanwhile keeping the "optical surface" heated; "baking of the optical element, evacuation of the chamber and vaporization of the coating material are continued until a suitable layer of the desired thickness * * * has been deposited," (page 2, col. 1, lines 64-68). None of the earlier patents disclosed this sequence, and the nearest were as follows. In November, 1925, Fink and Beers filed the application that issued on December 10, 1929, as Patent No. 1,738,991. It was for a process of coating the inner surfaces of the vacuum chamber [Volume III 307a] of a thermos bottle with vaporized metal, such as magnesium. The purpose of such a coating is to maintain the temperature in the chamber by excluding the heat from the air, or the heat from the contents of the bottle. In April, 1929, Winkler and two others applied in Germany for a patent that issued in this country as Patent No. 1,982,774 on December 4, 1934. This was for mirrors made by condensing in a vacuum vaporized metals—e.g.

an alloy of aluminum and silver—upon a polished base. ("The adhering capacity of the mirror coatings on metallic substrata is quite considerably increased by keeping the polished metallic substrata hot during the deposition of the mirror coatings.") There were three earlier patents for coating the upper part of the inside of an electric bulb, so that none of the light should be reflected upwards. There were also patents for mirrors, designed of course to reflect the light; and therefore the opposite of the patented coatings, whose purpose is to transmit through the "optical surface" as much as possible of the light falling upon it. The defendant indeed insists—relying for this on line 12, col. 1, page 1, of the specifications in suit—that "mirrors" are among those "optical surfaces" or "elements" that the invention covers. However, regardless of any significance of that word where it appears, there cannot be the least doubt that the invention is only for a "light-transmitting optical" element; indeed the coating itself is spoken of as "a light-transmitting evaporated film" (page 1, col. 1, lines 47, 48). The explanation for the inclusion of "mirrors" may be that, as the reflecting coating of a mirror is usually on the rear surface of a transparent plate, it is desirable to have as little light as possible [Volume III 308a] reflected from the front of the plate. so that all would reach the reflecting surface. The purpose of all these patents so widely diverged from that of Lyon that under § 100 (b) they would not serve as anticipations, even if the sequence of steps had more closely anticipated his process.

On the other hand Cartwright and Turner took out three earlier patents that were much nearer to Lyon's, for they disclosed coating an "optical surface" with a film of "inorganic salt." The first—No. 2,207,656—was applied for in December, 1938 and issued on July 8, 1940. It disclosed a process of depositing a coating of non-reflecting substances—"metallic fluorides"—upon a lens or the like by vaporizing it in a vacuum "in the manner now generally well known in the silvering of

mirrors and the like" (page 2, col. 1, lines 21-23). The second—No. 2,281,474—was applied for in March 1939 and issued on April 28, 1942. It disclosed a method of superimposing at least two coatings of different "indices of refraction"; and presupposed the vaporization of "inorganic substances" in a vacuum. The third—No. 2,281,475—was applied for in August 1939 and issued on the same day as the second: it was for a process (and for its product) of coating a lens with similar substances by vaporizing them in a vacuum and thereafter "baking" at from 350° to 500° C. in order to increase their resistance to detachment—"ruggedness"—a practice that became known in the art as "post-baking." The specifications of none of these patents suggested that the "optical surface" should itself be kept hot while it was being coated; the nearest approach to this being in the third patent which did declare it desirable to bake the "surface" at between [Volume III 309a] 400° to 450° C. before vaporization (page 1, col. 1, lines 41-45) —a step that has come to be known as "preheating," and that is, as we have said, the first step of the patented process. Thus, although Lyon's advance lay only in keeping the "optical surface" itself heated while it was being coated, this had not appeared in any patent or printed publication on November 17, 1942. Before considering whether the patent may depend upon it, we will consider whether Lyon's process had been "in public use or on sale" under § 102 (b); or whether "the invention was made • • • by another" before Lyon, under § 102 (g).

Cartwright was one of the most experienced experts in this field, and had been active in experiment even before the year 1938. The military services, and particularly the Navy, were particularly anxious to find a practical way of coating binoculars, periscopes and other "light-transmitting" glass surfaces, which should make the film at once tenacious and viable. Indeed, some of the testimony imputes to the services a scarcely under-

standable estimate of the importance of such a coating. The trouble had been that all the earlier coatings, though their proper composition was known, could be readily scratched or even rubbed off. One condition of success was well understood: before being coated the glass surface should be made as clean as possible: all water or grease must be taken off. An accepted way to do this was Lyon's first step: heat the glass in a vacuum. Again, a familiar, perhaps the only practical, way was to coat the glass after it had been cleaned by vaporizing the "inorganic salt" in the same vacuum in which the glass had been "pre-heated." Finally, it was well understood that to "post-bake" added much to the tenacity of the bond and the "ruggedness" of the coating. [Volume III 310a] However, for some reason, apparently still not quite understood, the art never took Lyon's second step, now generally accepted as the way to secure the optimum bond of the coating to the glass.

Cartwright did indeed fully disclose even this in a letter, written on November 30, 1939, to one, Wilson, of the "Research Corporation," a company engaged in the exploitation of patents, in whose employ he then was, though his chief calling was that of instructor in physics in the Massachusetts Institute of Technology. This letter described the "development made during the last few months on 'invisible glass' "; and the third and ninth experiments which it describes we quote in the margin.* [Volume III 311a, 312a] Not only does the let-

*3. Glass was heated to 150°C, 300°C and 400°C in a vacuum and treated with evaporated magnesium fluoride and also cryolite. The heating was done by having the glass in contact with a heavy piece of chromium plated brass which was heated by a flame before putting on the bell jar. Of course, it could be heated electrically inside the bell jar. Part of the glass extended beyond the hot brass in order to control the effect of heating. At 150°C the cryolite film was noticeably harder where it had been heated but there was only a very slight difference in the hardness of the magnesium fluoride film. At 300°C both films

(*Footnote continued on following page*)

ter prove beyond cavil that Cartwright did conceive that to coat the glass in a vacuum, while heated, made the coating "very much harder," but it also shows not only that he had practiced it, but that he considered the possibility of "getting protection on the method": i. e. having it patented. Furthermore, on the day before—November 29th—he had told one, Hewlett, a physicist of the General Electric Company, of coating the glass while it was hot, and on December 4th Hewlett wrote to his own company describing that process, and adding that "the ruggedness of these films is very striking (see the two samples he gave me). They may be washed in tap water and even scratched with a knife blade without producing any scratches." Moreover, neither does the letter, nor any testimony, intimate that Cartwright imposed any promise of secrecy on Hewlett, although Hewlett might be regarded as in some sense a competitor. Hewlett experimented with the information he had

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(*Footnote continued from preceding page*)

were very much harder where they had been heated, especially the cryolite. At 400°C, the hardness of the films was remarkable and when they were waterproofed the cryolite seemed almost as hard as the magnesium fluoride and it was somewhat more transparent. I have been intending to heat the eye-glass lenses that were obtained from the American Optical Company by radiation while magnesium fluoride and cryolite was being evaporated. Dr. Hewlett said he had heated glass in vacuum by radiation during the evaporation and I do not know if we could obtain protection. My idea is to have the holder for the glass of polished metal chromium plated, have a filament heater back of the glass and surround all this with a polished metal shield. Glasses absorb radiation longer than 3u and polished metal reflects radiation beyond 3u very well. * * *

9. * * * I have made the equipment for heating the glass by radiation while the glass was being treated. The results were most pleasing and, if it is not too late, it would be worth while getting protection on the method. I have used this method for depositing cryolite, chiolite, magnesium fluoride and potassium fluorosilicate. * * * This looks like the logical way to treat photographic lenses during their manufacture as well as eye glasses.

got, and made a number of coatings in the summer of 1940, but finally decided to abandon the process, because he concluded that those coatings deposited on heated glass scratched more easily than those on unheated. Since his user was not only experimental, but in addition was abandoned, we disregard it under § 102 (g); as we also do the work of one, Begg, an employee of the Eastman Kodak Company, which that company attempted to re-uscitate later and to use as an anticipation of Lyon. But Cartwright's activities we may not so summarily dispose of, and to them we turn.

By the fall of 1939 he had already found that his work on non-reflective coatings took up so much of his time that he employed a student named Clark to help him, and Clark kept with [Volume III 313a] him until May, 1940. Before he left, Cartwright had enjoined upon him the strictest secrecy which Clark observed, not only while he was in Cartwright's employ, but, also, after he was employed by another company, the National Research Corporation. Cartwright himself continued to work for the Institute until August, 1940, when he went into the employ of the Navy for that month, during which, although he was engaged in making non-reflecting lenses, he did not use the patented process; nor does he appear to have told anyone about it. He gave as his reason for not using it that he had no apparatus that would produce a high enough vacuum. On the other hand, already while he was at the Institute, he made and sold coated lenses, as a private venture; and, after he left the Navy and went into the service of the Corning Glass Works at Corning, New York, he again took up the same business with the help of his wife. It resulted in a substantial income, at times amounting to $3,000 a year, and many, though not all, of the lenses were coated while hot.

Were these activities either a "public use" or "sale" under § 102 (b), or was Cartwright a prior inventor under

§ 102 (g)? True, the fact that the process could not be deduced from the lenses sold would not alone prevent their sale from being a "public use."* It is indeed difficult to see why this should be so, for such sales could not in fact enlighten the art, especially in the case of a process, which the product does not [Volume III 314a] ordinarily disclose, unlike a machine which may disclose its concealed mechanism, if it be dismantled. The law does not however appear to have made any such distinction. However, although such a product will be a "public use," it will be so only on condition that it is neither experimental, secret, nor abandoned; and we think that Cartwright abandoned his discovery as soon as it emerged from the stage of experiment. We do not rely upon the secrecy that he enjoined upon Clark except in so far as it goes to confirm the continued lack of finality of his activities. His disclosure to Hewlett is hardly consistent with unqualified secrecy, although it too is not inconsistent with the continued tentative character of what he was doing. But we agree with what Judge Burke said in his opinion. "Whatever experiments he had conducted * * * and whatever occasional use he had made of it in his commercial work had convinced him that it was inferior in results to his own patented post-baking method, and that the results obtained were not worth the effort, and did not warrant bringing it to light in the art. * * * His testimony at the trial leaves no doubt about the fact that he is still uncertain one 'could not get as hard a film if you left out the actual heating in the vacuum.'" The defendant replies that it is not necessary that a third party who puts the invention in "public use or sale" must understand the value and importance of his discovery. That is indeed true; a man may conceive a process, put

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* *Hall* v. *Macneale*, 107 U. S. 90, 97.
Brush v. *Condit*, 132 U. S. 39, 48, 49.
Electric Storage Battery Co. v. *Shimadzu*, 307 U. S. 5, 20.

it in "tangible form," test it out and fail to exploit [Volume III 315a] it, because he does not see how valuable it is. That was not, however, all that Cartwright did. He did indeed test it out to his satisfaction; and when he had done so, he concluded it would not do what he was after. It did not produce a more "rugged" film and he gave it up. It was in effect an abandonment; it did more than fail to advance the art; it put the process among those efforts that are proved useless. All the reasons that have made the courts refuse to treat experimental users as anticipations,* apply even more convincingly; it is not alone that such activities are not evidence of anticipation, they are evidence against. We do not forget that in *Corona Cord Tire Co.* v. *Dovan Chemical Corp.*, 276 U. S. 358, 383, the Supreme Court said of a process that it is "reduced to practice when it is successfully performed"; but it should be noted that the Court also declared that "the tests of Kratz" were not "abandoned laboratory experiments." We conclude therefore with Judge Burke that Cartwright neither put the process to "public use," nor was he its prior inventor.

Therefore we at length come to the question whether Lyon's contribution, his added step, was enough to support a patent. It certainly would have done so twenty or thirty years ago; indeed it conforms to the accepted standards of that time. The most competent workers in the field had for at least ten years been seeking a hardy, tenacious coating [Volume III 316a] to prevent reflection; there had been a number of attempts, none satisfactory; meanwhile nothing in the implementary arts had been lacking to put the advance into operation; when it appeared, it supplanted the existing practice and occupied substantially the whole field. We do not see

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* The Corn Planter Patent, 23 Wall. 181, 210, 211.
Electric Storage Battery Co. v. *Shimadzu, supra* (307 U. S. 5).

how any combination of evidence could more completely demonstrate that, simple as it was, the change had not been "obvious * * * to a person having ordinary skill in the art"—§ 103. On the other hand it must be owned that, had the case come up for decision within twenty, or perhaps, twenty-five years before the Act of 1952 went into effect on January 1, 1953, it is almost certain that the claims would have been held invalid. The Courts of Appeal have very generally found in the recent opinions of the Supreme Court a disposition to insist upon a stricter test of invention than it used to apply—indefinite it is true, but indubitably stricter than that defined in § 103.* Indeed, some of the justices themselves have taken the same view. ** The Act [Volume III 317a] describes itself as a codification of existing law, as it certainly is in the sense that the structure of the system remains unchanged. Moreover those decisions that have passed upon it have uniformly referred to it as a codification,

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* *Buono* v. *Yankee Maid Dress Corp.*, 77 Fed (2) 274, 276 (C. C. A. 2).

Cleveland Trust Co. v. *Strelber-Schroth Co.*, 108 Fed (2) 109, 112 (C. C. A. 6).

Picard v. *United Aircraft Corp.*, 128 Fed (2) 632, 636 (C. C. A. 2).

United States Gypsum Co. v. *Consolidated Expanded Metal Co.*, 130 Fed (2) 889, 892 (C. C. A. 6).

Trabon Engineering Corp. v. *Dirkes*, 136 Fed (2) 24, 27 (C. C. A. 6).

Cleveland Punch & Shear Works Co. v. *E. W. Bliss Co.*, 145 Fed (2) 991, 999 (C. C. A. 6).

Frank Adam Electric Co. v. *Colt's Patent Fire Arms Mfg. Co.*, 148 Fed (2) 497, 502 (C. C. A. 8).

Browne & Sharpe Mfg. Co. v. *Kar Engineering Co.*, 154 Fed (2) 48, 52 (C. C. A. 1).

Foxboro Co. v. *Taylor Instrument Co.*, 157 Fed (2) 226, 234 (C. C. A. 2).

Falkenberg v. *Bernard Edward Co.*, 175 Fed (2) 427, 429 (C. A. 7).

Alemite Co. v. *Jiffy Lubricator Co.*, 176 Fed (2) 444, 448, 449 (C. A. 8).

** *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560, 568-572.

although so far as we have found none of them has held that §103 did not change the standard of invention.* And so the question arises whether we should construe §103 as restoring the law to what it was when the Court announced the definition of invention, now expressly embodied in §103, or whether we should assume that no change whatever was intended. To decide that question it seems desirable to look briefly backward.

From 1793, when the second patent act was passed, ** until the Act of 1952, the only statutory standard for invention was that the discovery should be "new and useful"; and indeed the Act of 1952 itself repeats this same test in § 101. Congress did not try to define it but left it to the courts to develop by precedent. So far as we can find, it was not until 1850 that the Supreme Court made any such attempt; so that, although the disclosure must be "new," it was so, provided it had not been published or in public use and was original. However, in *Hotchkiss* v. *Greenwood,* 11 How. 248, the Court imposed an authoritative gloss upon the word, which it put in the following words (p. 267): "unless more ingenuity and skill [Volume III 318a] in applying the old method," were necessary "than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitutes es-

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* *Stanley Works* v. *Rockwell Mfg. Co.,* 203 Fed (2) 846 (C. A. 3).

General Motors Corp. v. *Estate Stove Co.,* 203 Fed (2) 912 (C. A. 6).

Pacific Contact Laboratories v. *Solex Laboratories,* 209 Fed (2) 529 (C. A. 9).

Interstate Rubber Products Corp. v. *Radiator Specialty Co.,* 214 Fed (2) 546 (C. A. 4).

Vincent v. *Suni-Citrus Products Co.,* 215 Fed (2) 305 (C. A. 5).

Wasserman v. *Burgess & Blacher Co.,* 217 Fed (2) 402 (C. A. 1).

** 1 Statutes at Large 318.

sential elements of every invention. In other words, the improvement is the work of a skillful mechanic, not that of the inventor." The instruction to the jury, the exception to which the court overruled, had been in substantially the same words, p. 253: if "no other ingenuity or skill" be "necessary to construct the knob than that of an ordinary mechanic acquainted with the business, the patent is void." Thereafter this became the standard rubric and was applied in many cases. The variants were numberless; and "invention" became perhaps the most baffling concept in the whole catalogue of judicial efforts to provide postulates for indefinitely varying occasions. However, the Court never formally abjured it; nor has it ever substituted any other definite test. Even *Cuno Engineering Corp.* v. *Automatic Devices Corporation*, 314 U. S. 84—which in expression probably was the furthest departure—recognized the continued authority of *Hotchkiss* v. *Greenwood, supra* (p. 90): "if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art." Again, page 91: "The principle of the *Hotchkiss* case applies to the adaptation or combination of old or well known devices for new uses."

We assume that the usual presumption against retroactivity would have applied to § 103, had the purpose not been so explicit to make the Act retroactive; but § 4(a) leaves no possibility of doubt as to that: It is to "apply to unexpired patents granted [Volume III 319a] prior to such date" January 1, 1953 "except as otherwise provided"; and all that was "otherwise provided" was in § 4(e): "Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction."* This

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* *United Mattress Machinery Co.* v. *Handy Button Machine Co.*, 207 Fed. (2) 1 (C. A. 3).

interpretation is, moreover, confirmed by the report of the House as to § 103, which we quote in the margin.* Therefore, we can see no escape from accepting the text as it reads, except as "at a later time * * * some criteria * * * may be worked out." It only remains to ask whether, if the change is to apply retroactively, the Act is pro tanto unconstitutional. Arguendo we will accept it as possible that the decisions of courts may give such an absoluteness to the words of a statute as to make a deliberate substitution of another locution the same as though the precedents had been incorporated verbatim into the statute; that, if that were true in the case at bar, the Act would in effect grant new monopoly; and, finally, that the grant of a new monopoly restrospectively would be invalid.** We may accept that hypothesis because the facts [Volume III 320a] do not fulfill the premises. In the first place § 103 only restores the original gloss, substantially in ipsissimis verbis; which has never been overruled; but on the contrary for seventy or eighty years had continued to be regarded as authoritative. Moreover—and this is the important consideration—although it may have ceased in practice to be followed, and had come to enjoy no more than lip service, there never has been the slightest intimation of any definite substitute; nothing more than an un-

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* There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius.

** cf. *Great Northern Railway* v. *Sunburst Oil & Refining Co.*, 287 U. S. 358.

expressed and unacknowledged misgiving about the increased facility with which patents were being granted. Such judicial attitudes are indeed the stuff of which much of the law is made; but we cannot agree that, however controlling upon the lower courts, they are a warrant for that solid assurance, the disappointment of which will make a statute invalid. Courts again and again shift their position; and, although they are apt to do so under cover of nice distinctions, they impose the risk of anticipating the changes upon those who may have acted upon the faith of the original. Certainly a legislature, whose will the courts have undertaken to proliferate, must be free to reinstate the court's initial interpretation, even though it may have been obscured by a series of later comments whose upshot is at best hazy.

Finally, we cannot agree that this retroactivity should be limited to a recognition of the patent only in the future: That is, that, although the patentee may enjoin its infringement after January 1, 1953, he may not recover damages for any earlier infringement or collect any profits of the infringer. As a matter of construction § 4(e) seems to us conclusive; it preserves any [Volume III 321a] "finding" of a court before January 1, 1953; but leaves the court free thereafter to apply the Act as though it had existed when the unexpired patent issued. Were we to deny the patentee the usual remedies, an anomalous situation would arise; for it would follow that, although an infringer would not be liable, quoad the recovery of damages or profits, for taking his chances in disregarding the patent, he would nevertheless have no protection for any investment or other industrial expense that he might have made before the date when the Act took effect. We should either accept as an adequate protection such assurance as infringers might have drawn from the earlier precedents, or we should find them as we do, too amorphous for that purpose. Believing that they will not serve, we hold that the patent should be regarded as valid ab initio for all purposes.

There remains only one other point of enough importance to demand discussion: i. e. whether what Lyon had done before November 17, 1941,—a year before his filing date—forfeited his right to a patent under § 102 (b) of the Act: that is, [Volume III 322a] whether he had put it in "public use or on sale in this country more than one year prior to the date of application." Lyon began to work for the Naval Research Laboratory in January, 1941, trying to find an effective coating. By the middle of June, 1941, he was assured that he "had consistent results as far as hardness and adherence of the film was concerned." He "appeared to be on the right track"; but much testing had still to be done. Nevertheless, "by the first of July" he "was reasonably certain that" he "was getting a hard durable film * * * remarkably consistent in the results." "Many, many tests were made," which, however, by September, 1941 had convinced him "that we were in a position to try this thing out on some actual simple instruments." There were a number of old binoculars, which were given to him to coat and it was arranged that these should be introduced surreptitiously, so that the users would not know which had been coated by the new process and which had not. From binoculars he went to other instruments, so that by October first the "Optical Shop of the Naval Gun Factory" had "completed certain experimental work," and "estimated that $10,000" was "required to provide for equipment and further research." The "experimental work" had "developed to such a stage as to place the product in production." The officer in charge concluded the letter from which we quote by requesting that the Bureau of Ordinance should approve a "project" for $20,000 both for "production equipment in the shop" and for five units for "repair activities afloat." Such an approval was issued on October 30; but it is to the last degree unlikely that any production should have taken place within three weeks, that was not part of the "further research" deemed necessary on October 1st. [Volume III

323a] At any rate it is clear that the defendant, which had the burden, did not prove its defence. Its theory is that, if with Lyon's consent the Navy exploited the process, it was the same as though he had done so himself; indeed in the end the Navy's exploitation would be far more profitable to him than any sales that he could personally make. It is not necessary to pass upon the legal validity of that interpretation of § 102 (b), because, though we should accept it arguendo, it was not proved, as we have just said.

We agree with Judge Burke's searching and comprehensive analysis, and the judgment will be affirmed.

Judgment affirmed.

[Volume III 324a]

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT.

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the 20th day of June one thousand nine hundred and fifty-five.

Present:

Hon. Learned Hand,
Hon. Thomas W. Swan,
Hon. Carroll C. Hincks,
Circuit Judges.

DEAN A. LYON,

Plaintiff-Appellee,

v.

BAUSCH & LOMB OPTICAL CO.,

Defendant-Appellant.

Appeal from the United States District Court for the Western District of New York.

This cause came on to be heard on the transcript of record from the United States District Court for the Western District of New York, and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby ordered, adjudged, and decreed that the judgment of said District Court be and it hereby is affirmed.

/s/ A. DANIEL FUSARO
Clerk

[Volume III 360a]

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 216 October Term, 1954.

Petition filed July 11, 1955 Decided July 29, 1955

Docket No. 23345

DEAN A. LYON,

Plaintiff-Appellee,

v.

BAUSCH & LOMB OPTICAL CO.,

Defendant-Appellant.

Before: HAND, SWAN and HINCKS, Circuit Judges.

On petition by the defendant-appellant for a rehearing upon the decision of this court on June 20, 1955, affirming a judgment of the District Court for the Western District of New York holding valid and infringed claims 1, 2, 3, 4, 5, 8 and 9 of Patent No. 2,398,382.

Edward H. Cumpston, for the Petitioner.

PER CURIAM:

The petition for rehearing is denied except as to the point raised by the first two sentences of Point IV, subdivision 1, thereof. As to the point thus excepted from denial further consideration brings us to the conclusion that the patent specifications fail adequately to support claims 1, 2, 4 and 5 which describe the coating claimed therein in terms so broad as to include materials which, so far as the proofs [Volume III 361a] show, produce optical surfaces which are not light-transmitting surfaces.

We hold, therefore, that, without disturbing our affirmance as to claims 3, 8 and 9, the decree below must be reversed as to claims 1, 2, 4 and 5 for lack of adequate disclosure. With leave, however, to the plaintiff, if so advised, to file a petition for rehearing addressed to the holding above stated, containing any pertinent argument not covered in his earlier briefs.

[Volume III 362a]

UNITED STATES COURT OF APPEALS

SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals in and for the Second Circuit, held at the United States Court House, in the City of New York, on the 29th day of July, one thousand nine hundred and fifty-five.

Present:

Hon. Learned Hand,
Hon. Thomas W. Swan,
Hon. Carroll C. Hincks,
Circuit Judges.

DEAN A. LYON,
Plaintiff-Appellee,

v.

BAUSCH & LOMB OPTICAL CO.,
Defendant-Appellant.

A petition for a rehearing having been filed herein by counsel for the appellant,

Upon consideration thereof, it is

Ordered that said petition be and hereby is denied except as to the point raised by the first two sentences of Point IV, subdivision 1, thereof.

Further ordered that the previous affirmance of the judgment below as to claims 3, 8 and 9 be and it hereby is confirmed but that as to claims 1, 2, 4, and 5 the judgment below be and it hereby is reversed for lack of adequate disclosure with leave to the appellee, if so advised, to file a petition for rehearing limited in accordance with the opinion of this Court.

/s/ A. DANIEL FUSARO
Clerk